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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,122	02/05/2001	Heinz Greiner	188.463	2422

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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT PAPER NUMBER

3683

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,122

Applicant(s)

GREINER, HEINZ

Examiner

Lan Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-52)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed 8/9/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: page 1 of the Response, line 2 of insert A, "quarter circle cross section for the balls 3". Applicant argues that the "quarter circle cross section" is supported by the original disclosure. The Examiner disagrees. The original specification and drawings do not describe nor illustrate this feature. The drawings that the Applicant enclosed with the Response dated 8/9/02 do not provide proofs that the feature "quarter circle cross section" is part of the original specification. Furthermore, these drawings illustrate different structures of a bearing assembly, which the Examiner believes that is not the same as the invention.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Note that the amended feature " α to be about 15°" has been accepted; since α is illustrated in figure 2 and described in the specification on page 5.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 claims "another raceway ... approximately quarter circle cross-section for the balls" on lines 3 and 4. This raceway has been claimed on line 6 of claim 1. Applicant's figure 1 shows only one raceway 11 with a quarter circle cross-section. It is believed that Applicant intended for claim 1 to recite a --half circle cross-section-- on line 6 instead of "quarter circle cross-section".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 claims "another raceway ... approximately quarter circle cross-section for the balls" on lines 3 and 4. This raceway has been claimed on line 6 of claim 1. Applicant's figure 1 shows only one raceway 11 with a quarter circle cross-section. It is believed that Applicant intended for claim 1 to recite a --half circle cross-section-- on line 6 instead of "quarter circle cross-section".

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tonogai.

Re: claims 1, 2 and 7, Tonogai shows a linear rolling bearing, as in the present invention, comprising: a guide carriage with a U-shaped cross section in figure 8 having a U-crossbar and two U-legs so that the guide carriage forms a carriage cavity and partially surrounds a guide rail while being slidably supported through balls on two longitudinal sides of the guide rail, each U-leg of the guide carriage having on an inner surface opposing the guide rail a ground raceway with an approximately quarter circle cross-section for the balls and stop surface 21 having a retaining contour for a guide member 50 containing the balls B is configured on a guide rail-distal outer surface of each U-leg of the guide carriage. Tonogai discloses the structure of the linear rolling bearing as claimed in claim 1. Tonogai is silent of a process of grinding the stop surface and the raceway of the U-leg using one grinding wheel and are made in one common work step. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed Tonogai's linear rolling bearing using a one step process in order to save cost and time. Saving cost and time is always a

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goal in any manufacturing process. It appears that the Applicant is claiming the linear rolling bearing by the process that it is made. The court rules, see In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), that the determination of patentability in a product-by process claim is based on the product itself, even though the claim may be limited and defined by the process.

Re: claim 4, figure 7(a) shows the guide member 50 to be detachably fixed on the guide carriage and extend in longitudinal direction from raceways of the guide rail 96, the balls form endless ball circuits and the guide members comprise for each ball circuit, a region for load-bearing balls, a return canal for returning balls and two deflecting canals that connect the region for load-bearing balls and the return canal to each other at ends thereof.

Re: claim 5, see figures 7(a) and 8.

Re: claim 6, figure 8 shows the opening of the lower return canal to be smaller than the diameter of the balls inserted in the return canal.

Allowable Subject Matter

10. Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 8/9/02 have been fully considered but they are not persuasive. Applicant's argument about the 112, 1st and 2nd paragraph rejections of claim 3 has been considered but they are not persuasive as discussed above in the objection to new matter. As for Applicant's argument about the art rejection, Tonogai shows a bearing assembly with the same structure as claimed in claim 1. The Examiner maintains that claim 1 is a product-by process claim wherein the patentability is based on the product itself.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is 703-308-8347.

The examiner can normally be reached on M-F, 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4177.

XLN

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October 15, 2002

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

